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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,280	11/12/2003	Patrick Guiney	11.037011 US	9311
41696 7590 08/01/2008 VISTA IP LAW GROUP LLP 12930 Saratoga Avenue Suite D-2 Saratoga, CA 95070				
			EXAMINER	
			HYUN, PAUL SANG HWA	
		ART UNIT	PAPER NUMBER	
		1797		
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		08/01/2008 PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/712,280

**Applicant(s)**

GUINEY, PATRICK

**Examiner**

PAUL S. HYUN

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-6, 8-19, 21-23, 25-43, 57 and 58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 8-19, 21-23, 25-43, 57 and 58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/2/08.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### REMARKS

The amendment filed by Applicant on 09 May 2008 has been acknowledged. Claims 1, 2, 4-6, 8-19, 21-23, 25-43, 57 and 58 are currently pending.

The IDS filed by Applicant has been acknowledged.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1, 2, 4, 11, 12, 16, 17 and 57** are rejected under 35 U.S.C. 102(e) as being anticipated by Somack et al. (US 2003/0098271 A1).

Somack et al. disclose a sample tray 50 configured to be processed by a work station (see [0010]). The tray comprises an array of apertures wherein a cylindrical filter membrane 54 for immobilizing a sample (e.g. blood, tissue, microorganisms) is positioned in each aperture (see Fig. 7). The tray can comprise a bar code associated with each aperture for storing data related to the filter, such as the type of filter used to immobilize the sample and the test to be performed on the sample (see [0009] and [0060]).

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With respect to claim 16, it is evident that each bar code comprises a unique registration number. Otherwise, the bar code reader would not be able to identify and distinguish each bar code.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims **14-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al.

With respect to claims 14 and 15, Somack et al. do not explicitly disclose that the bar codes can store information such as the number/parameters of processing steps involving the filter. However, the reference does disclose that the bar codes can store information directed towards the intended application of each sample and filter (see [0009]). In light of the disclosure, it would have been obvious to one of ordinary skill in the art to store the procedural steps for accomplishing the intended application in each bar code so that the intended applications can be automated.

With respect to claim 16, although Somack et al. do not explicitly disclose that each bar code comprises a unique registration number, it would have been

obvious to provide each bar code with a unique registration number so that the bar code reader can identify and distinguish the bar codes.

Claims **5, 6, 18, 19, 21-23, 29-31, 33-35, 39-41, 43 and 58** are rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al. in view of Morrison (US 2004/0126281 A1).

Somack et al. do not disclose the use of read only memory (ROM), read/write memory, or a processor.

Morrison discloses a specimen container 10 comprising a filter 14 for immobilizing a sample. The container comprises a bar code or a non-volatile RAM that can store information related to the sample (see [0032]). The container is capable of docking with a testing apparatus that can access the memory (see [0017]). In light of the disclosure of Morrison, it would have been obvious to one of ordinary skill in the art to provide the tray disclosed by Somack et al. with an electronic memory, such as a RAM or a ROM, instead of a bar code, so that the information can be quickly communicated to and from the work station.

With respect to claims 33 and 34, Somack et al. do not explicitly disclose that the bar codes can store information such as the number/parameters of processing steps involving the filter. However, the reference does disclose that the bar codes can store information directed towards the intended application of each sample and filter (see [0009]). In light of the disclosure, it would have been obvious to one of ordinary skill in the art to store the procedural steps for

accomplishing the intended application in the memory so that the intended applications can be automated.

With respect to claim 35, although Somack et al. do not explicitly disclose that each data comprises a unique registration number, it would have been obvious to provide individual data with a unique registration number so that the memory can identify and distinguish each data.

With respect to claims 39 and 40, Somack et al. disclose another embodiment of the invention comprising a tray for receiving vials 8 (see Fig. 2). The reference discloses that the vials can comprise bar codes that correspond to bar codes assigned to each aperture in the tray so that the correct vials can be inserted into each aperture of the tray (see [0060]). In light of the disclosure, it would have been obvious to one of ordinary skill in the art to provide the modified Somack et al. tray with vials comprising data storage means that correspond to the apertures of the modified tray so that the transfer of samples stored in vials to the tray can be automated.

Claims **25-28, 36 and 37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al. in view of Morrison as applied to claims 5, 6, 18, 19, 21-23, 29-31, 33-35, 39-41, 43 and 58, and further in view of Marsh et al. (US 5,219,294).

Although Morrison discloses that the container can be docked with a testing apparatus, neither Somack et al. nor Morrison explicitly disclose how the docking is accomplished.

Marsh et al. disclose a parallel port connector for connecting two electrical devices (e.g. computer and printer). The connector comprises a symmetrical recess comprising tapered surfaces 38a and 38b to ensure a solid physical connection (see Figs 1 and 6 and line 51, col. 3). In light of the disclosure of Marsh et al., it would have been obvious to one of ordinary skill in the art to provide the modified Somack et al. tray with a serial connection disclosed by Marsh et al. so that the tray can be securely docked with the work station.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al. in view of Morrison as applied to claims 5, 6, 18, 19, 21-23, 29-31, 33-35, 39-41, 43 and 58, and further in view of Crosby (US 6,770,487 B2).

Neither Somack et al. nor Morrison disclose that the information stored in the memory includes the expiration date of the filter medium.

Crosby discloses an absorbent medium for collecting a biological sample thereon. The absorbent medium further comprises a bar code wherein one of the information stored in the bar code is the expiration date of the absorbent medium (see lines 10-15, col. 4). In light of the disclosure of Crosby, it would have been obvious to one of ordinary skill in the art to store in the memory the expiration date of each filter medium of the modified Somack et al. tray to ensure proper preservation of the samples.

Claims 38 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al. in view of Morrison as applied to claims 5, 6, 18,

19, 21-23, 29-31, 33-35, 39-41, 43 and 58, and further in view of McDevitt et al. (US 2002/0045272 A1).

Neither Somack et al. nor Morrison disclose a wireless interface or an electro-optical interface.

McDevitt et al. disclose a sample container that is capable of interfacing with a testing apparatus. The container can communicate with the testing apparatus wirelessly or by means of infrared sensors (see [0558]). In light of the disclosure of McDevitt et al., it would have been obvious to one of ordinary skill in the art to interface the modified Somack et al. tray with the work station wirelessly or by means of infrared sensors.

Claims **8-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al. in view of Morrison and Marsh et al.

Somack et al. do not disclose a data storage device that is positioned in a recess.

Morrison discloses a specimen container 10 comprising a filter 14 for receiving a sample. The container can comprise a memory storage means in the form of a non-volatile RAM that can store information related to the sample (see [0032]). The memory storage means enables information to be shared upon docking with a testing apparatus. Marsh et al. disclose a parallel port connector for connecting two electrical devices (e.g. computer and printer). The connector comprises a symmetrical recess comprising tapered surfaces 38a and 38b to ensure a solid physical connection (see Figs 1 and 6 and line 51, col. 3).



In light of the disclosure of Morrison, it would have been obvious to one of ordinary skill in the art to provide the tray disclosed by Somack et al. with an electronic memory, such as a RAM or a ROM, instead of a bar code, so that information to and from the work station can be updated quickly. In light of the disclosure of Marsh et al., it would have been obvious to one of ordinary skill in the art to provide the modified Somack et al. tray with the serial connection disclosed by Marsh et al. so that the tray can be securely docked with the work station.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al. in view of Crosby.

Somack et al. do not disclose that the information stored in the bar code includes the expiration date of the filter medium.

Crosby discloses an absorbent medium for collecting a biological sample thereon. The absorbent medium further comprises a bar code wherein one of the information stored in the bar code is the expiration date of the absorbent medium (see lines 10-15, col. 4). In light of the disclosure of Crosby, it would have been obvious to one of ordinary skill in the art to store in the bar codes the expiration date of each filter medium disclosed by Somack et al. to ensure proper preservation of the samples.

***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but they are moot in view of the new grounds of rejection. The amendments necessitated new grounds of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL S. HYUN whose telephone number is (571)272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul S Hyun/  
Examiner, Art Unit 1797

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797